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MEMORANDUM

DATE: August 30, 2004

TO: John J. Love
Director, Technology Center 3600

FROM: Robert J. Spar
Director, Office of Patent Legal Administration

SUBJECT: Remand of Application 09/374,598 in view of *Ex Parte Eggert et al.*

Application No. 09/374,598 has been remanded to the examiner from the Board of Patent Appeals and Interferences (BPAI) in view of its precedential opinion, *Ex Parte Eggert et al.*, Appeal No. 2001-0790 (Bd. Pat. App. & Inter. May 29, 2003). The remanded application is being returned to the Technology Center, via the Office of Patent Legal Administration (OPLA), for reconsideration of the recapture rejection under 35 U.S.C. 251, made by the examiner of record on June 17, 2003 in the examiner's answer, Paper No. 21, in view of *Eggert*.

To assist the Technology Center in evaluating the remanded application, OPLA has conducted a preliminary review of the application file, its contents, and the recapture rejection found in Paper No. 21. These findings are attached. In light of this preliminary review, OPLA recommends that the following action be taken by the examiner with respect to the application file:

Withdraw the appealed recapture rejection as being no longer appropriate in view of *Eggert* or other reasons identified in the attached remarks. The attached remarks by OPLA present a rationale for the recommended withdrawal of the rejection and may be used in the next action taken by the examiner.

Further Assistance: For questions relative to the materials provided above, please contact Ken Schor at 308-6710, or Elizabeth Dougherty at 306-3156, both of the Office of Patent Legal Administration, or by e-mail. For questions as to recapture in general, the examiners should consult the Special Program Examiners (SPREs) of the Technology Centers.

Attachment: OPLA Comments Paper

BPAI REMAND
APPL. NO. 09/374,598

A recapture rejection would not be appropriate in the present reissue application in view of the following analysis.

In accordance with the Board's decision in *Ex parte Yamaguchi*, 61 USPQ2d 1043 (Bd. Pat. App. & Inter. 2001)(reported but unpublished, precedential), see MPEP 1412.02, part I.B.2.C, an examiner's statement of reasons for allowance which identifies a claim limitation as the basis for allowing the original application does not result in that limitation being surrendered, and cannot serve as a basis for recapture, unless the Applicant files comments on the reasons for allowance which either support the examiner's statement of reasons for allowance or indicate some other limitation in the claim as distinguishing over the prior art, wherein the other limitation would cause a surrender of subject matter not containing the limitation. In the instant case, while Applicant did file comments on the reasons for allowance in the remarks submitted on 3/27/96 (paper no. 8), the comments did not support the examiner's statement of reasons for allowance. Therefore, a recapture rejection based on the examiner's statement of reasons for allowance would not be appropriate.

In addition, the following limitations were highlighted by Applicant in Applicant's remarks submitted on 9/25/05 (paper no. 6) in the original application for patent (08/262,505) as, independently of one another, distinguishing over the prior art :

Limitation A: "a series of first narrow bracing members extending from positions adjacent a mid-point of said narrow strip member to positions spaced a short distance from the ends of said end plates"

Limitation B: "wherein said top of one said panel is substantially thicker than the bottom thereof, said outer surface of said one panel is profiled to extend outwardly and upwardly from said bottom thereof to said top thereof, and wherein said inside surface of said thicker part is partially cut away in areas spaced from said bridging members"

These claims were included, alternatively or together, in the claims of the patent which issued from the original application (patent no. 5,657,600).

Looking at the reissue application:

All of the independent claims in the reissue application contain limitation A or a modified form of limitation B¹, or both. As such, this fact situation falls within that of *Ex parte Eggert*, Appeal No. 2001-0790 (Bd. Pat. App. & Inter. May 29, 2003)(a precedential opinion of an expanded panel of the Board). See also MPEP 1412.02, section I.C, p. 1400-18, column 1, paragraph 3, which states that if the reissue claim recites a broader form of the key limitation added/argued during original prosecution to overcome an art rejection (and therefore not entirely removing that

¹ Note that dependent claim 26 contains limitation B as presented in the claims of the patent which issued from the original application (patent no. 5,657,600), i.e., an unmodified form of limitation B.

key limitation), then the reissue claim may not be rejected under the recapture doctrine. A breakdown of the independent reissue claims and which of limitations A and/or a modified form of B is included in the claims is as follows:

I. Claim 17 contains limitation A as:

“a series of first narrow bracing members extending from positions adjacent a mid-point of said narrow strip member to positions spaced a short distance from the ends of said end plates”

II. Claim 23 contains limitation A as:

“a series of first narrow bracing members extending from positions adjacent a mid-point of said narrow strip member to positions spaced a short distance from the ends of said end plates”

III. Claim 24 contains a modified form of limitation B as:

“wherein said first panel extends at an obtuse angle with respect to the vertical to define a supporting shelf”

Note that this limitation is considered to be a modified form of limitation B as it, like limitation B, relates to the specific form of the panel and its resulting ability to provide a supporting shelf. Applicant's remarks submitted on 9/25/05 (paper no. 6) in the original application for patent (08/262,505) on page 7 specify that limitation B above allows “the poured concrete to flow into a part of the thickened portion of the foam, thereby forming a series of concrete fingers integral with the wall to provide much of the support for the brick wall.”

IV. Claim 41 contains limitation A as:

“a series of first narrow bracing members extending from positions adjacent a mid-point of said narrow strip member to positions spaced a short distance from the ends of said end plates”

V. Claim 42 contains limitation A as:

“a series of first narrow bracing members extending from positions adjacent a mid-point of said narrow strip member to positions spaced a short distance from the ends of said end plates”

VI. Claim 43 contains a modified form of limitation B as:

"wherein said first panel extends at an obtuse angle with respect to the vertical such that building material poured into said space flows into said cavities to form with said first panel a supporting shelf"

VII. Claim 44 contains both limitation A and a modified form of limitation B as:

"a series of first narrow bracing members extending from positions adjacent a mid-point of said narrow strip member to positions spaced a short distance from the ends of said end plates"

and

"wherein said first panel extends at an obtuse angle with respect to the vertical to define a supporting shelf"

VIII. Claim 45 contains a modified form of limitation B as:

"wherein said third panel extends at an obtuse angle with respect to the vertical and defines with said fourth panel a second space...and said second space includes a cavity defined by said third panel...said cavity having a width at the top thereof that is substantially greater than the panel thickness at the bottom of said third panel...a finger formed by building material received in said cavity, said finger defining with said third panel a supporting shelf"

Based on the above analysis, it is clear that the independent reissue claims either maintained limitation A as presented in the originally filed application for patent or contained a modified and broadened form of limitation B², thereby placing this fact situation within that of *Ex parte Eggert*, Appeal No. 2001-0790 (Bd. Pat. App. & Inter. May 29, 2003)(a precedential opinion of an expanded panel of the Board). As such, it is suggested that the appealed rejection which is based on recapture be withdrawn by the examiner, and the content of the above be used in the next action taken.

The above analysis of the claims was solely directed to, and limited to, the legal issue of whether the recapture rejection should be maintained or not. Unless specifically identified above, additional issues such as prior art rejections and compliance with 35 U.S.C. 112 have not been addressed, and a general screening of the case has not been carried out. Accordingly, if the application is allowed, further review by the TC SPRE as per MPEP 1456 will be provided.

Upon incorporation of the above comments into any action taken by the examiner, this paper should be removed from the file.

² Note that dependent claim 26 contains limitation B as presented in the claims of the patent which issued from the original application (patent no. 5,657,600), i.e., an unmodified form of limitation B.